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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/863,749	05/23/2001	Tadashi Fukumoto	Ishii Case 16	9164
7590 FLYNN, THIEL, BOUTELL & TANIS, P.C. 2026 Rambling Road Kalamazoo, MI 49008-1699			EXAMINER SPAHN, GAY	
			ART UNIT 3635	PAPER NUMBER
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**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

1 UNITED STATES PATENT AND TRADEMARK OFFICE

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4 BEFORE THE BOARD OF PATENT APPEALS  
5 AND INTERFERENCES  
6  
7

8 *Ex parte* TADASHI FUKUMOTO and TSUYOSHI HASHIMOTO  
9

10  
11 Appeal No. 2007-1342  
12 Application No. 09/863,749  
13 Technology Center 3700  
14  
15

16 Decided: December 20, 2007  
17  
18

19 Before WILLIAM F. PATE, III, HUBERT C. LORIN, and JENNIFER D. BAHR,  
20 *Administrative Patent Judges*.

21  
22 PATE, III, *Administrative Patent Judge*.  
23

24  
25 DECISION ON APPEAL  
26

27 This is an appeal from the Final Rejection of claims 15, 18, 21, and 23-24,  
28 and from the Examiner's refusal to allow claims 13 and 16 as amended after final  
29 rejection. Claims 6, 7, 12, 22, 25, and 26 stand allowed. Claims 14 and 17 stand  
30 objected to as directed to allowable subject matter, and claims 1-5, 8-11, 19 and 20  
31 have been canceled.

32 We have jurisdiction under 35 U.S.C. §§ 134 and 6.

33 The claimed invention is directed to a submerged breakwater to act as an  
34 artificial reef near the shoreline of the ocean. The breakwater generally comprises

1an open box having a vertical wall on the offshore side, the top of the box is  
2characterized by inclined slits.

3 Claim 13, reproduced below, is further illustrative of the claimed subject  
4matter.

5 13. A submerged breakwater generating structure comprising an open  
6 box having a vertical wall for producing a breakwater at an offshore side,  
7 said vertical wall having at least one opening at a lower end and slits  
8 inclined with respect to the direction along which waves propagate  
9 disposed at the top portion of said box and having openings provided in a  
10 spaced-apart relationship between said vertical wall and a second vertical  
11 wall of said open box.  
12

13 The reference of record relied upon by the Examiner as evidence of  
14anticipation and obviousness is:

15 Yamamoto<sup>1</sup>(as translated) JP-55110520 Aug. 2, 1980  
16

17 Claims 13, 15, and 21 stand rejected under 35 U.S.C. § 102 as anticipated by  
18JP 55-110520.

19 Claims 16, 18, 23, and 24 stand rejected under 35 U.S.C. § 103 as  
20unpatentable over JP 55-110520.

21 We have carefully reviewed the rejections on appeal in light of the  
22arguments of the Appellants and the Examiner. As a result of this review, we have  
23determined that the Examiner has not established the lack of novelty or the prima  
24facie obviousness of the claims on appeal. Therefore the rejections on appeal are  
25reversed.

26 OPINION

27 The law with respect to preambles is well settled. Preamble language that  
28merely states the purpose or intended use of an invention is generally not treated as  
29limiting the scope of the claim. See *Boehringer Ingelheim Vetmedica, Inc. v.*

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4Hereinafter referred to as JP 55-110520.

1*Schering-Plough Corp.*, 320 F.3d 1339, 1345 (Fed. Cir. 2003); *Rowe v. Dror*, 112  
2F.3d 473, 478 (Fed. Cir. 1997). However, the preamble is regarded as limiting if it  
3recites essential structure that is important to the invention or necessary to give  
4meaning to the claim. *NTP, Inc. v. Research In Motion, Ltd.*, 418 F.3d 1282, 1305-  
506 (Fed. Cir. 2005), *cert. denied*, 74 U.S.L.W. 3421 (U.S. Jan. 23, 2006); *SanDisk*  
6*Corp. v. Memorex Prods., Inc.*, 415 F.3d 1278, 1284 n.2 (Fed. Cir. 2005), *cert.*  
7*denied*, 126 S.Ct. 829 (2005).

8 For example, in *Rowe v. Dror*, a catheter claimed in the preamble as a  
9“balloon angioplasty catheter” was held by our reviewing court to be patentable  
10over a catheter of general utility even though this description of the claimed subject  
11matter appeared only in the preamble to the claim. Therein, the court stated that  
12the

13 claim preamble has the import that the claim as a whole suggests for it.  
14 Where a patentee uses the claim preamble to recite structural limitations of  
15 his claimed invention, the PTO and courts give effect to that usage.  
16 Conversely, where a patentee defines a structurally complete invention in the  
17 claim body and uses the preamble only to state a purpose or intended use for  
18 the invention, the preamble is not a claim limitation [citations omitted].  
19

20 *Rowe v. Dror*, 112 F.3d at 478. In essence, the court examined the entire  
21specification and the arguments and found that the preambular recitation was, in  
22fact, a structural limitation of Rowe’s claimed subject matter.

23 In the present case, our review of the record as a whole, including  
24Appellants’ disclosure and arguments on appeal, reveals that the recitation of a  
25“submerged breakwater” is directed to the kind or type of breakwater Appellants  
26are claiming and should be regarded as a structural limitation. We do not regard  
27this as a mere intended use as the Examiner has suggested. When Appellants  
28indicate by argument and amendment that they are to be bound by the preambular

1 structural limitations, then these limitations should be given full weight in the  
2 examination process. That is, if the claim drafter “chooses to use *both* the  
3 preamble and the body to define the subject matter of the claimed invention, the  
4 invention so defined, and not some other, is the one the patent protects.” *Bell*  
5 *Commc'ns Research, Inc. v. Vitalink Commc'ns Corp.*, 55 F.3d 615, 620 (Fed. Cir.  
6 1995).

7 In the instant case the applied reference is not directed to a submerged  
8 breakwater as admitted by both the Appellants and the Examiner. The Yamamoto  
9 breakwater has the low front side submerged and the high rear side extending  
10 above the water surface. (Yamamoto, page 5, ll. 10-12). Waves are intended to  
11 break on the concrete swash-plate 2. (Yamamoto, page 7, ll. 16-22). Thus, the  
12 Examiner’s argument (Answer 7:7) that the breakwater of the applied reference is  
13 capable of performing as a submerged breakwater is based on speculation.  
14 Therefore, the reference does not anticipate the subject matter of Appellants’  
15 claims. With respect to obviousness, the Examiner points to no evidence that it  
16 would have been obvious to use the breakwater of the applied reference as a  
17 submerged breakwater. Accordingly, the obviousness rejection can not be  
18 sustained.

19 Furthermore, we disagree with the Examiner’s contention in the  
20 Supplemental Answer that the claims are not directed to a “fully submerged  
21 breakwater.” (Supplemental Answer 1:11). The ordinary and customary meaning  
22 of “submerged” is under water. Finally, we disagree with the Examiner’s  
23 contention that placing the breakwater of the applied reference on a mound, as  
24 called for in claims 16 and 24, would have been *prima facie* obvious. There is no  
25 evidence to support such a legal conclusion on the part of the Examiner.

17Appeal 2007-1342  
18Application 09/863,749  
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REVERSED

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